

## REMARKS

### **I. Introduction**

With the addition of new claim 20, claims 1 to 20 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicant notes with appreciation the acknowledgment of the claim for foreign priority and the indication that all certified copies of the priority documents have been received.

Applicant thanks the Examiner for considering the previously filed Information Disclosure Statement, PTO-1449 paper and cited references.

### **II. Objection to Claim 6**

Claim 6 was objected to for not ending with a period. In this regard, claim 6 has been amended herein without prejudice to conclude with a period, thereby obviated the present objection. As such, withdrawal of this objection is respectfully requested.

### **III. Rejection of Claim 1 Under 35 U.S.C. § 102(e)**

Claim 1 was rejected under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,637,257 ("Sparks"). It is respectfully submitted that Sparks does not anticipate claim 1 for at least the following reasons.

Claim 1 relates to a potentiometric sensor device for measuring pH value. As amended herein without prejudice, claim 1 recites an evaluation circuit in communication with the electrodes, the evaluation circuit configured to detect a degradation process of a motor oil. Support for this amendment may be found, for example, at page 3, lines 3 to 11 of the Specification.

Sparks relates to a micromachined fluid analysis device and method. Sparks does not disclose, or even suggest, an evaluation circuit configured to detect a degradation process of a motor oil.

As indicated above, Sparks does not disclose, or even suggest, all of the features of claim 1. As such, it is respectfully submitted that Sparks does not anticipate claim 1.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

**IV. Rejection of Claims 2 and 3 Under 35 U.S.C. § 103(a)**

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks and U.S. Patent No. 5,215,643 ("Kusanagi et al."). It is respectfully submitted that the combination of Sparks and Kusanagi et al. does not render unpatentable the present claims for at least the following reasons.

Claims 2 and 3 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, Sparks does not disclose, or even suggest, all of the features recited in claim 1. Kusanagi et al. are not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by Sparks. Indeed, Kusanagi et al. do not disclose, or even suggest, the features of claim 1 not disclosed or suggested by Sparks.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks and Kusanagi et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks and Kusanagi et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

**V. Rejection of Claims 4 to 7 Under 35 U.S.C. § 103(a)**

Claims 4 to 7 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks, Kusanagi et al., and U.S. Patent No. 5,904,987 ("Tani et al."). It is respectfully submitted that the combination of Sparks, Kusanagi et al., and Tani et al. does not render unpatentable the present claims for at least the following reasons.

Claims 4 to 7 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, the combination of Sparks and Kusanagi et al. does not disclose, or even suggest, all of the features recited in claim 1. Tani et al. are not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by the combination of Sparks and Kusanagi et al.. Indeed, Tani et al. do not disclose, or even suggest, the features of

claim 1 not disclosed or suggested by the combination of Sparks and Kusanagi et al..

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks, Kusanagi et al., and Tani et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks, Kusanagi et al., and Tani et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

**VI. Rejection of Claim 8 Under 35 U.S.C. § 103(a)**

Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks, Kusanagi et al., Tani et al., and U.S. Patent No. 5,126,034 ("Carter et al."). It is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al., and Carter et al. does not render unpatentable claim 8 for at least the following reasons.

Claims 8 ultimately depends from claim 1 and therefore includes all of the features recited in claim 1. As more fully set forth above, the combination of Sparks, Kusanagi et al., and Tani et al. does not disclose, or even suggest, all of the features recited in claim 1. Carter et al. are not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by the combination of Sparks, Kusanagi et al., and Tani et al. Indeed, Carter et al. do not disclose, or even suggest, the features of claim 1 not disclosed or suggested by the combination of Sparks, Kusanagi et al., and Tani et al.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al., and Carter et al. does not disclose, or even suggest, all of the features of claim 8. As such, it is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al., and Carter et al. does not render unpatentable claim 8. Accordingly, withdrawal of the present rejection is respectfully requested.

**VII. Rejection of Claims 9 to 13 Under 35 U.S.C. § 103(a)**

Claims 9 to 13 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks and U.S. Patent No. 3,843,400 ("Radford et al."). It

is respectfully submitted that the combination of Sparks and Radford et al. does not render unpatentable the present claims for at least the following reasons.

Claims 9 to 13 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, Sparks does not disclose, or even suggest, all of the features recited in claim 1. Radford et al. are not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by Sparks. Indeed, Radford et al. do not disclose, or even suggest, the features of claim 1 not disclosed or suggested by Sparks.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks and Radford et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks and Radford et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

#### **VIII. Rejection of Claims 14 and 15 Under 35 U.S.C. § 103(a)**

Claims 14 and 15 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks and U.S. Patent No. 6,357,089 ("Koguchi et al."). It is respectfully submitted that the combination of Sparks and Koguchi et al. does not render unpatentable the present claims for at least the following reasons.

Claims 14 and 15 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, Sparks does not disclose, or even suggest, all of the features recited in claim 1. Koguchi et al. are not relied upon for disclosing or suggesting the features of claim 1 not disclosed or suggested by Sparks. Indeed, Koguchi et al. do not disclose, or even suggest, the features of claim 1 not disclosed or suggested by Sparks.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks and Koguchi et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks and Koguchi et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

**IX. Rejection of Claims 16 and 17 Under 35 U.S.C. § 103(a)**

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks, Kusanagi et al., and Koguchi et al. It is respectfully submitted that the combination of Sparks, Kusanagi et al., and Koguchi et al. does not render unpatentable the present claims for at least the following reasons.

Claims 16 and 17 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, Sparks does not disclose, or even suggest, all of the features recited in claim 1 and neither of Kusanagi et al. and Koguchi et al. disclose, or even suggest, the features of claim 1 not disclosed or suggested by Sparks.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks, Kusanagi et al., and Koguchi et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks, Kusanagi et al., and Koguchi et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

**X. Rejection of Claims 18 and 19 Under 35 U.S.C. § 103(a)**

Claims 18 and 19 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Sparks, Kusanagi et al., Tani et al., and Koguchi et al. It is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al., and Koguchi et al. does not render unpatentable the present claims for at least the following reasons.

Claims 18 and 19 ultimately depend from claim 1 and therefore include all of the features recited in claim 1. As more fully set forth above, Sparks does not disclose, or even suggest, all of the features recited in claim 1 and none of Kusanagi et al., Tani et al., and Koguchi et al. disclose, or even suggest, the features of claim 1 not disclosed or suggested by Sparks.

In view of all of the foregoing, it is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al., and Koguchi et al. does not disclose, or even suggest, all of the features of the present claims. As such, it is respectfully submitted that the combination of Sparks, Kusanagi et al., Tani et al.,

and Koguchi et al. does not render unpatentable the present claims. Accordingly, withdrawal of the present rejection is respectfully requested.

**XI. New Claim 20**

New claim 20 has been added. It is respectfully submitted that new claim 20 adds no new matter and is fully supported by the present application, including the Specification. Support may be found, for example, at page 8, lines 4 to 23 of the Specification.

Since claim 20 depends from claim 1 and therefore includes all of the features of claim 1, it is respectfully submitted that claim 20 is patentable over the references relied upon for at least the same reasons set forth above in support of the patentability of claim 1.

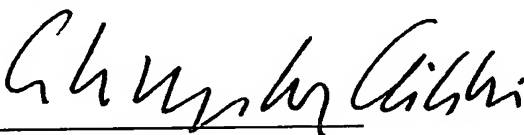
**XII. Conclusion**

It is therefore respectfully submitted that all of the presently pending claims are allowable. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is earnestly solicited.

Respectfully submitted,

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Sept 10, 2000 By:

  
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